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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,752	09/29/2006	Christophe Carola	MERCK-3236	4926
23599 7590 01/02/2009 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER				
MAIER, LEIGH C				
ART UNIT		PAPER NUMBER		
1623				
MAIL DATE		DELIVERY MODE		
01/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,752

Applicant(s)

CAROLA ET AL.

Examiner

Leigh C. Maier

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13 is/are rejected.
- 7) ☒ Claim(s) 10-12 and 14-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 9/29/06

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

Claims 10-12 and 14-18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Instant claim 10 depends from both claim 1 and claim 8. See MPEP § 608.01(n). Accordingly, the claims are not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-9 and 13, the phrase “preferably” (or “such as, preferably” or “particularly preferably”) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Further regarding claim 8, the claim recites reacting components “at elevated temperature.” “Elevated” is a relative term, rendering the claim indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyoko (JP 10-114640) and Buschmann et al (J. Cosmet. Sci., 2002) in view of Milewski et al (Polish J. Chem., 1998). Because Kyoko is in Japanese, the examiner is relying on the PAJ abstract and a machine translation to indicate its contents. The citations will refer to these documents.

Kyoko teaches the preparation of cosmetic compositions comprising a variety of chromone derivatives. See abstract and paragraphs [0012]-[0014]. The reference further teaches that the chromone compounds are difficult to prepare in formulations because they precipitate from solution, so the compositions are not stable. The reference further suggest the addition of other typical cosmetic ingredients, such as antioxidants (e.g. amino acids) and UV filters (e.g. p-aminobenzoic acid and derivatives). See paragraphs [0009]. The reference does not teach a complex of a chromone derivative with a cyclodextrin.

Buschmann teaches that cyclodextrins have utility as excipients in cosmetic compositions. See Introduction. The cyclodextrin act by complexing with compounds and can provide a number of advantages including solubilization. See pages 186 and 188-9 (Solubilization of the guest molecules).

Milewski teaches that a number of compounds having the chromone nucleus form complexes with cyclodextrins. See abstract and Figure 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare a cosmetic composition comprising a cyclodextrin complex of a chromone derivative. The artisan would be motivated to prepare a cosmetic composition with said complex for the increased stability that the cyclodextrin would be expected to provide for the chromone compound. One of ordinary skill would reasonably expect success in preparing such a complex because it is known that similar chromone derivatives form complexes with cyclodextrins. In the absence of unexpected results, it would be within the scope of the artisan to select any of the typically available cyclodextrins. In the absence of unexpected results, it would be further obvious to include any of the typical cosmetic components taught by Kyoko for their combined effects.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyoko (JP 10-114640) and Buschmann et al (J. Cosmet. Sci., 2002) in view of Milewski et al (Polish J. Chem., 1998) and further in view of Hedges (Chem. Rev., 1998).

Kyoko, Buschmann and Milewski teach as set forth above. The references do not teach the method of preparation recited in claim 8.

Methods of preparing cyclodextrin complexes, including reacting the two components at temperatures above ambient, are well known in the art. See Hedges at section I. A. Hedges also addresses the use of cyclodextrins in cosmetics and the stabilization of complexed compounds. See Table I and section III. C.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare a cosmetic composition comprising a chromone/cyclodextrin complex as set forth above. It would be further within the scope of the artisan to select any known process, such as those taught by Hedges, and optimize the relative molar amounts of the components through routine experimentation, to prepare such a product with a reasonable expectation of success.

Examiner's hours, phone & fax numbers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Maier whose telephone number is (571) 272-0656. The examiner can normally be reached on Tuesday, Thursday, and Friday 7:30 to 4:00 (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anna Jiang (571) 272-0627, may be contacted. The fax number for Group 1600, Art Unit 1623 is (571) 273-8300.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/Leigh C. Maier/
Primary Examiner, Art Unit 1623
December 19, 2008